

App. Serial No. 10/518,849
Docket No.: DE020165

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Remarks

Claims 1-5 are currently pending in the patent application. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated December 27, 2006 indicated that claims 1-2 and 4 stand rejected under 35 U.S.C. § 103(a) over Eck *et al.* (US 5,038,130) in view of Hinz *et al.* (US 2002/0171418); and claims 3 and 5 stand rejected under 35 U.S.C. § 103(a) over Eck in view of Hinz as applied above, and further in view of Seefeldt (US 5,744,950) or Sampey (US 5,877,705).

Applicant respectfully traverses the Section 103(a) rejections of claims 1-5 (all of which rely upon a proposed modification of the Eck reference) because the modification proposed in the Office Action would undermine or defeat the purpose of the Eck reference. According to M.P.E.P. § 2143.01, a Section 103 rejection cannot be maintained when the asserted modification undermines the purpose of main reference. See, *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). A stated purpose of the Eck reference is to provide a system for sensing changes in a magnetic field which is less sensitive to temperature changes and manufacturing tolerances (see, e.g., Col. 2:32-37). More specifically, the Eck reference uses specific circuits which increase the sensitivity of the resistive circuit to changes in the magnetic field (see, e.g., Col. 2:52-54). These circuits are placed between a magnet 16 and a rotating wheel 12 that has a plurality of equally spaced protruding teeth 14 (see, e.g., Col. 1:54-62 and figures 3, 9a and 9b). The circuits detect changes in the strength of the magnetic field caused by the varying distance between the magnet-wheel arrangement as its wheel rotates (see, e.g., Col. 1:64 to Col. 2:13). The Office Action proposes replacing Eck's magnet-wheel arrangement with the magnetized encoder taught by the Hinz reference. However, this modification would cause the Eck embodiment to cease functioning. If one were to replace the magnet-wheel arrangement with the magnetized encoder 2 of Hinz (see, e.g., figure 1), one would be removing the (rotating) arrangement that the circuits of the Eck reference are specifically designed to sense. Thus, Eck's intended purpose and operation become null and void.

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Accordingly, under MPEP § 2143, the Section 103(a) rejections of claims 1-5 are improper and Applicant requests that they be withdrawn.

The Section 103(a) rejections are also improper because the Hinz reference (U.S. Publication No. 2002/0171418) does not qualify as prior art under Section 103. More specifically, Applicant hereby invokes §103(c) and alleges that the subject matter of the claimed invention and of the cited Hinz reference “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” According to M.P.E.P. §706.02, the rejection under 35 U.S.C. 103(a) should be withdrawn because “(s)ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” This portion of the M.P.E.P. goes on to state that such subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention.

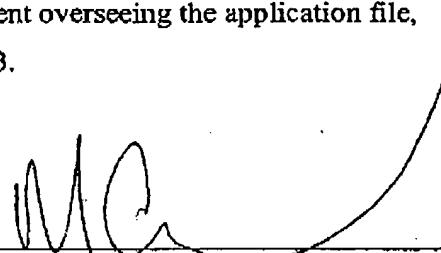
The Hinz reference was published on November 21, 2002, and the instant application is entitled to a priority date of at least June 27, 2002 (via DE 10228662.0). Thus, Applicant assumes that the Hinz reference has been asserted as prior art under Section 102(e). The Hinz reference and the instant application to Hinz *et al.* were at all relevant times assigned to Koninklijke Philips Electronics N.V. Accordingly, Applicant submits the Hinz reference does not qualify as prior art by way of Section 102(e) and Section 103(c). Therefore, the Section 103(a) rejections of claims 1-5 are improper and must be withdrawn.

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In view of the above, Applicant believes that each of the Section 103 rejections has been overcome and accordingly understands that the claims should be in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawielski, of NXP Corporation at (408) 474-9063.

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131

By: 
Name: Robert J. Crawford
Reg. No.: 32,122
(NXPS.224PA)